

REMARKS

The Office Action dated February 4, 1999 has been carefully reviewed. Claims 1-17 are pending in this patent application. Reconsideration of this application, in light of the following remarks, is respectfully requested.

OBJECTION TO THE SPECIFICATION \ REJECTION OF CLAIMS 1-17 UNDER 35 U.S.C. § 112 FIRST PARAGRAPH

The Examiner objects to the specification as failing to provide antecedent basis for the claimed subject matter. In addition, the Examiner has rejected claims 1-17 under 35 U.S.C. § 112 for lack of enablement. In particular, the Examiner states the following on page 2, lines 3-6 and 14-19, of the Office Action.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitation that the "thickness is less than 10.0 mils" is not supported by the specification.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "the first layer having a thickness in the range of 1 to 2 mils" (page 4, lines 2-3 and page 10, lines 10-11), does not reasonably provide enablement for the limitation that "said thickness is less than 10.0 mils" as recited in independent claims 1 and 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

As acknowledged by the Examiner, Applicant's specification states the following:

The non-woven layer of the present invention preferably has a thickness in the range of 1 to 2 mils. The advantage of having a non-woven layer in the aforementioned thickness range is that the layer is thick enough to absorb and laterally disperse fluid it comes into contact with, but remains pliable enough to be very drapable. (see page 10, lines 10-14)

Applicant understands the Examiner's argument to be the following. Since the specification only explicitly states 1 to 2 mils as the preferred thickness values for the first layer (i.e. the non-woven layer), other thickness values less than 10.0 mils are not enabled. Stated another way, the Examiner is arguing that an artisan, after reading the teachings of Applicant's specification, including that 1 to 2 mils is the preferable thickness for the non-woven layer, would **not** be able to make and use a drop cloth which has a non-woven layer which is, for example, 3, 5, or 9 mils thick.

Applicant respectively disagrees with the above discussed argument and directs the Examiner's attention to the fact that the Court has stated the following:

The first paragraph of 35 U.S.C. § 112 requires that the scope of the claims bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art. In cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the same sense that, ***once imagined***, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved. *In re Fisher*, 427 F.2d 833, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970). (Emphasis added.)

In addition, the Court has stated that:

The law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention. *International rectifier Corp. v. SGS-Thomson microelectronics Inc.*, 38 U.S.P.Q.2d 1083, 1086 (Cal. 1994).

Applicant submits that the thickness of the non-woven layer recited in claim 1 is a mechanical element of the present invention. Therefore, *after reading the Applicant's specification*, constructing a drop cloth with a non-woven layer having a thickness less than 10.0 mils (e.g. 1–9 mils) would only involve predictable factors well within the capabilities of a person of ordinary skill in the art. For

example, after reading in the Applicant's specification how to construct a drop cloth having a non-woven layer with a 1 to 2 mil thickness, an artisan would certainly be able to construct a drop cloth of the present invention having a non-woven layer with a, for example, 5 mil thickness. As such, the Examiner will appreciate that the explicit description of a non-woven layer having a thickness of 1 to 2 mils provided in the Applicant's specification provides broad enablement, and thus supports other thickness values for the non-woven layer of the present invention. Therefore, the Applicant is not required under the law to explicitly describe each and every thickness (i.e. less than 10.0 mils) for the non-woven layer in order to support such a limitation in claim 1. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 112 be withdrawn.

The Applicant further points out that the Court has stated the following:

In examining a patent application, the PTO is required to assume that the specification complies with the enablement provisions of § 112 unless it has "*acceptable evidence or reasoning* " to suggest to the otherwise. *The PTO must provide reasons supported by the record as a whole why the specification is not enabling.* Then and only then does the burden shift to the applicant to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation. *Gould v. Mossinghoff*, 229 U.S.P.Q. 1 (D.C. 1985) (Emphasis added.)

Accordingly, if the Examiner maintains the aforementioned rejection after considering the above discussion she/he is respectfully requested to provide reasons supported by the record as a whole why the specification is not enabling. In particular, the Examiner is respectfully requested to set forth acceptable evidence or reasoning as to why an artisan, after reading the teachings of Applicant's specification, would **not** be able to make and use a drop cloth which has a non-woven layer which is, for example, 3, 5, or 9 mils thick.

REJECTION OF CLAIMS 1-17 UNDER 35 U.S.C. § 112 FIRST PARAGRAPH

The Examiner has rejected claims 1-17 under 35 U.S.C. § 112 for failing to reasonably provide enablement for "a plastic material" as recited in claims 1

and 10. In particular, on pages 2 and 3, lines 20-21 and 1-5, respectively, of the Office Action the Examiner states the following:

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling "a liquid impervious and/or solvent resistant plastic material" (page 6, lines 8-10), does not reasonably provide enablement for "a plastic material" as recited in claims 1 and 10. The specification does not enable any person skilled in the art to which it pertains, or with it is most nearly connected, to make the invention commensurate in scope with these claims. The term "plastic material" can include a polymeric fiber or fabric material which may or may not be liquid impervious.

The above discussion regarding the enablement of the limitation "less than 10.0 mils" is relevant to the subject rejection. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

If the Examiner maintains the subject rejection after considering the remarks contained herein she/he is respectfully requested to provide reasons supported by the record as a whole why the specification is not enabling. In particular, the Examiner is respectfully requested to set forth acceptable evidence or reasoning as to why an artisan, after reading the teachings of Applicant's specification, would not be able to make and use a drop cloth of the present invention because, as stated by the Examiner,

The term "plastic material" can include a polymeric fiber or fabric material which may or may not be liquid impervious. (see page 3, lines 4-5 of the Office Action).

REJECTION OF CLAIMS 9 and 17 UNDER 35 U.S.C. § 112 FIRST PARAGRAPH

The Examiner has rejected claims 9 and 17 under 35 U.S.C. § 112 for failing to reasonably provide enablement for "an adhesive material" as recited in claims 9 and 17. In particular, on page 3, lines 6-16, of the Office Action the Examiner states the following:

Claims 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "a layer of adhesive material... that facilitates the temporary attachment of bottom layer 14 to surface 11" (page 6, lines 16-18), does not reasonably provide enablement for "an adhesive material" as claimed in said claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification teaches that "the bottom layer is treated to resist slipping across or moving relative to surface 11" (page 6, lines 15-16) and that the "drop cloth 10 can be repeatedly removed and reattached to surface 11" (page 6, lines 19-20). However, as presently claimed "an adhesive material" includes permanent adhesives, and temporary adhesives, which may or may not meet all the requirements described in the specification.

The above discussion regarding the enablement of the limitation "less than 10.0 mils" is also relevant to the subject rejection. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

If the Examiner maintains the subject rejection after considering the remarks contained herein she/he is respectfully requested to provide reasons supported by the record as a whole why the specification is not enabling. In particular, the Examiner is respectfully requested to set forth acceptable evidence or reasoning as to why an artisan, after reading the teachings of Applicant's specification, would not be able to make and use a drop cloth of the present invention because, as stated by the Examiner,

"an adhesive material" includes permanent adhesives, and temporary adhesives (see page 3, lines 15 and 15).

REJECTION OF CLAIMS 4-6, 9, 10, 12, and 13 and 17 UNDER 35 U.S.C. § 112 SECOND PARAGRAPH

The Examiner has rejected claims 4, 5, 6, 9, 10, 12, and 13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Discussion Re: Patentability of Claims 4 and 12

Claims 4 and 12 have been amended in accordance with the Examiner's, suggestion. Thus, the Applicant respectfully requests that the rejection be withdrawn.

Discussion Re: Patentability of Claims 5 and 13

Claims 5 and 13 have been amended in accordance with the Examiner's, suggestion. Thus, the Applicant respectfully requests that the rejection be withdrawn.

Discussion Re: Patentability of Claim 6

Claim 6 has been amended to more clearly define the invention. Accordingly, the Applicant respectfully requests that the rejection be withdrawn.

Discussion Re: Patentability of Claims 9 and 17

Claims 9 and 17 have been amended to more clearly define the invention. Thus, the Applicant respectfully requests that the rejection be withdrawn.

REJECTION OF CLAIMS 1-3, 7, 8, 10, 11, 15, and 16 UNDER 35 U.S.C. § 103 (Garland/Reaves)

The Examiner rejected claims 1-3, 7, 8, 10, 11, 15, and 16 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,266,390 issued to Garland in view of U.S. patent 5,368,912 issued to Reaves. The Examiner specifically states on pages 5 and 6, lines 12-23 and 1-10, respectively, that:

Garland discloses a drop cloth comprising (a) a first layer of a spunbonded polypropylene nonwoven (b) a second of a liquid impervious plastic film layer of polyethylene or polypropylene, (c) a third layer of a spunbonded polypropylene nonwoven, wherein the nonwoven layers are absorbent (claim 1, col. 5, line 50-col. 6, line 17). The thickness of the nonwoven layers is within the range claimed by the Applicant (claim 3, lines 20-23). The layers are bonded together by heat through a nip roller (col. 4, lines 36-63).

Hence, it can be seen that the Garland patent teaches the limitations of said claims with the exception that the nonwoven layer contain natural or rayon fibers. Garland teaches polypropylene for the nonwoven. However, Garland also teaches the importance of said nonwoven being absorbent of "liquids including moisture, paint thinners, wood stains and solvents..." (col. 3, lines 60-66). Natural fibers, especially cotton fibers, and rayon fibers are well known in the art of absorbent nonwovens. Thus, it would have been obvious to one of ordinary skill in the art to substitute one well-known absorbent fiber for another in produce an absorbent nonwoven. For example, Reaves teaches the equivalence of a cotton absorbent nonwoven and a polypropylene absorbent nonwoven (col. 2. lines 55-65) in a protective cover laminate. Therefore, said claims are rejected as being obvious over the cited prior art.

Discussion Re: Patentability of Claims 1 and 10

The Examiner is respectfully reminded that the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Garland is devoid of any discussion relating to natural fibers or rayon. Reaves fails to cure the aforementioned deficiency of Garland since Reaves fails to suggest any motivation for, or desirability of, constructing a drop cloth having a non-woven fabric material that includes natural fibers or rayon.

Presumably, the Examiner's statement that,

Reaves teaches the equivalence of a cotton absorbent nonwoven and a polypropylene absorbent nonwoven (col. 2. lines 55-65) in a protective cover laminate.

is an attempt to provide the requisite teaching or suggestion in Reaves. However, Applicant respectfully submits that the aforementioned statement with regard to Reaves is a mischaracterization of the prior art. The passage in Reaves the Examiner refers to reads as follows:

The protective cover of the invention can be made from a variety of natural or synthetic materials, including a variety of woven fabrics such as cotton sheeting or a variety of plastic sheeting. However, according to a preferred embodiment, the protective cover 10 of the invention is made from an air permeable, nonwoven polypropylene sheet weighing 1.50 ounces per square yard and manufactured by Kimberly-Clark Corp.

which has the advantage of being lightweight, inexpensive and resistant to condensation.

The Examiner will appreciate that this passage only teaches that the protective cover can be made from either a natural or synthetic material, it is devoid of any discussion relating to the absorptive characteristics of either type of material. Moreover, nowhere in this passage, or anywhere else in Reaves, does it teach that a cotton absorbent non-woven and a polypropylene absorbent non-woven are equivalent in terms of their absorptive capacity. In fact, Reaves never discusses the absorptive capacity of his protective cover 10. Moreover, the discussion in Reaves is primarily directed to the perimeter edge 14 and elastic strips 16 and 22 of protective cover 10, and is not directed to the material the protective cover 10 is made from.

In light of the above discussion, Applicant respectfully submits that the Examiner has relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Applicant reminds the Examiner that the Court has stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). As such, Applicant respectfully submits that a prima facie case of obviousness has not been established and requests that the rejection be withdrawn.

If the above discussed rejection is maintained after considering the above remarks, Applicant respectfully requests that the Examiner specifically identify (e.g. by column and line number) where Garland or Reaves provide the motivation for, or desirability of, constructing a drop cloth having a non-woven fabric material that includes natural fibers or rayon.

Discussion Re: Patentability of Claims 2, 3, 7, 8, 11, 15, and 16

Claims 2, 3, 7, and 8 include claim 1 as a base claim. As a result, claim 2, 3, 7, and 8 are allowable for the reasons hereinbefore discussed with regard to claim 1. Claims 11, 15, and 16 include claim 10 as a base claim. As a result, claim 11, 15, and 16 are allowable for the reasons hereinbefore discussed with regard to claim 10.

REJECTION OF CLAIMS 6 and 14 UNDER 35 U.S.C. § 103 (Garland/Reaves)

Claims 6 and 14 respectively include claims 1 and 10 as base claims. As a result, claims 6 and 14 are allowable for the reasons hereinbefore discussed with regard to claims 1 and 10.

REJECTION OF CLAIMS 4, 5, 12, and 13 UNDER 35 U.S.C. § 103 (Garland/Reaves)

Claims 4 and 5 include claim 1 as a base claim. As a result, claims 4 and 5 are allowable for the reasons hereinbefore discussed with regard to claim 1. Claims 12 and 13 include claim 10 as a base claim. As a result, claims 12 and 13 are allowable for the reasons hereinbefore discussed with regard to claim 10.

REJECTION OF CLAIMS 9 and 17 UNDER 35 U.S.C. § 103 (Garland/Reaves)

Claims 9 and 17 respectively include claims 1 and 10 as base claims. As a result, claims 9 and 17 are allowable for the reasons hereinbefore discussed with regard to claims 1 and 10.

Conclusion

In view of the foregoing amendment and remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bradford G. Addison", is written over a horizontal line.

Bradford G. Addison
Attorney for Applicant
Registration No. 41,486

July 27, 1999

Maginot, Addison & Moore
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis, IN 46204-5130
Phone: (317) 638-2922
Fax: (317) 638-2139